

### Remarks

Claims 1-8 and 32-43 are pending in this application. No claims amendments are made in this paper, and no new matter has been introduced. Applicants respectfully submit that the pending claims are allowable for at least the reasons stated below.

### The Rejection Under 35 U.S.C. § 103 Should Be Withdrawn

On pages 2-3 of the final Office Action, the pending claims are rejected as allegedly obvious. In particular, it is alleged that the claims are obvious over Jeffery *et al.*, *J. Chem. Soc., Perkin Trans.*, 1: 2583-9 (1996) (“Jeffery”) because Jeffery discloses racemic mixtures of certain compounds whose stereoisomers are encompassed by claim 1. In the Examiner’s words:

[t]he expectation with regard to enantiomers is that activities as they pertain to living system are expected to be different ... The fundamentals of optical activity and stereoisomerism are well known to person having ordinary skill in the art. A person having ordinary skill in the art would have known how to resolve the racemic mixture and would have been motivated to do so with the reasonable expectation of achieving enantiomers having substantially different pharmacological activity.

Office Action, page 2. For support, the Examiner cites to *In re Adamson*, 275 F.2d 952 (C.C.P.A. 1960). Applicants respectfully traverse this rejection.

It is well-settled that three basic criteria must be met to establish a case of *prima facie* obviousness: first, there must have been at the time of the invention a motivation to combine the references cited; second, the alleged prior art must teach or suggest all of the limitations of the claims alleged to be obvious; and third, there must have been at the time of the invention a reasonable expectation of success. Manual of Patent Examining Procedure (“MPEP”), § 2142. In addition, a *prima facie* case of obviousness may be rebutted by showing that the claimed invention achieves unexpected results or by showing that the art teaches away from the claimed range. MPEP § 2144.05(III) (emphasis added).

As Applicants previously pointed out in their responses, a *prima facie* case of obviousness cannot be established by Jeffery. Specifically, Applicants provided that: 1) Jeffery fails to teach the stereoisomers of the claimed compounds; and 2) Jeffery would not have provided those of ordinary skill in the art with the motivation to make

and use the claimed compounds because Jeffery discloses that the pharmacological activity of sibutramine is mediated predominantly by sibutramine metabolites other than those claimed in this application. Response of April 12, 2004, page 7. The Examiner does not provide any evidence or arguments to refute these arguments. Instead, the Examiner essentially asserts that a stereoisomer of a compound whose racemic mixture's structure and activity are known cannot be patented *per se*. This assertion is incorrect.

It is well-settled that each obviousness determination should rest on its own facts. *See, e.g., In re Grabiak*, 769 F.2d 729, 731 (Fed. Cir. 1985) ("Generalization should be avoided insofar as specific chemical structures are alleged to be *prima facie* obvious one from another."). Thus, *prima facie* obviousness of a claimed compound cannot be established if its assertion is based on nothing more than a structural similarity between the claimed compound and those in the prior art. *See, e.g., Yamanouci Pharm. Co., Ltd. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339, 1343 (Fed. Cir. 2000) ("a *prima facie* case of obviousness requires structural similarity between claimed and prior art subject matter ... where the prior art gives reason or motivation to make the claimed compositions.") (emphasis added). In addition, courts have consistently held that a finding of *prima facie* obviousness must be based on a consideration of the *Graham* factors, *e.g.*, the scope and content of the prior art, the difference between the prior art and the claimed invention, and the level of ordinary skill in the art. *See, e.g., In re Mayne*, 104 F.3d 1339, 1341 (Fed. Cir. 1997) (stating that determination of facts as to the *Graham* factors are fundamental to the legal determination under 35 U.S.C. § 103).

This requirement is no different in the context of claims directed to enantiomers of a known racemic compound. *See, e.g., Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 2004 WL 2973831, --- F.Supp. 2<sup>nd</sup> --- (N.D.W.Va). For example, in *Ortho-McNeil*, the court rejected defendants' assertions that enantiomers are *per se* obvious over the racemic compound, pointing out that such assertions "are inconsistent with the Federal Circuit's directive to make *Graham* findings in every case to establish a *prima facie* case of obviousness." *Id.* at \*30, fn. 19 (citing *In re Mayne*, 104 F.3d at 1341; *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 663 (Fed. Cir. 2000)).


In view of the above,<sup>1</sup> Applicants respectfully submit that a rejection of the pending claims as *prima facie* obvious over nothing more than Jeffery's disclosure of racemic compounds cannot stand.

In sum, Applicants respectfully submit that all of the pending claims are allowable, and request that the rejection of the pending claims under 35 U.S.C. § 103 be withdrawn.

No fee is believed due for this submission. Should any additional fees be due for this submission or to avoid abandonment of the application, please charge such fees to Jones Day Deposit Account No. 503013.

Respectfully submitted,

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<sup>1</sup> Applicants respectfully submit that the Examiner's reliance on *In re Adamson* is misplaced, as the facts in that case are entirely unlike those here. In that case, the prior art not only disclosed the racemate of the claimed compound, but taught that it had the same spasmolytic activity for which the claimed compound was to be used. *In re Adamson*, 275 F.2d at 952-953. But the art at issue here (*i.e.*, Jeffery) teaches away from the claimed invention by teaching that the racemic compounds it discloses are likely to be pharmacologically inactive.